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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/089,871	06/04/1998	RUDOLF CAROLUS MARIA BARENDSE	251502008600	3289
25225 7590 05/06/2008 MORRISON & FOERSTER LLP 12531 HIGH BLUFF DRIVE SUITE 100 SAN DIEGO, CA 92130-2040				
EXAMINER				
RAMIREZ, DELIA M				
ART UNIT		PAPER NUMBER		
1652				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/089,871

Applicant(s)

BARENDSE ET AL.

Examiner

Delia M. Ramirez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18, 19, 21, 22, 24, 26-28, 31-35, 41-46, 48 and 50-52 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18, 19, 21, 22, 24, 26-28, 31-35, 41-46, 48 and 50-52 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Application

Claims 18-19, 21-22, 24, 26-28, 31-35, 41-46, 48, 50-52 are pending.

Applicant's amendment of claims 18, 22, 34, 44, 46, cancellation of claims 23, 47, a declaration by Dr. Lutz End, employee of the assignee of record of the instant application, and supporting references as submitted in a communication filed on 1/24/2008 are acknowledged.

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn.

Claim Rejections - 35 USC § 112, Second Paragraph

1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
2. Claims 18-19, 21-22, 24, 26-28, 31-35, 41-46, 48, 50-52 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claims 18-19 remain indefinite in the recitation of "increased pelleting stability" for the reasons of record and those set forth below. See the Non Final action mailed on 7/27/2007 for detailed discussion of this rejection.
4. Applicant traverses the rejections on the grounds that one of skill in the art would know that the term refers to the stability of the enzyme after pelleting. Applicant refers to the End declaration in support of this position and refers to specific passages of that declaration where it is stated that the Examples provided in the specification of the instant specification, specifically Example 5, refers to the stability of the enzyme and not to the structural stability of the pellet. Said declaration also refers to several prior art references and cite specific parts of these references as support to the argument that this

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term would be understood to be in reference to enzyme stability. Applicant also refers to a decision by the Board of Patent Appeals and Interferences of an appeal in U.S. Application No. 10/125272.

5. Applicant's arguments have been fully considered but are not deemed persuasive to overcome the instant rejection. The Examiner acknowledges Example 5 of the instant application, the End declaration, the references submitted, and a copy of the decision by the BPAI on an appeal in U.S. Application No. 10/125272. However, the Examiner disagrees with Applicant's contention that the term is not indefinite. First, even if it is assumed that the term "pelletting stability" refers to the stability of the enzyme after pelletting, it is reiterated herein that the term is unclear and confusing in the absence of a basis for comparison (i.e., increased with respect to what).

With regard to the BPAI decision regarding application No. 10/125272, the Examiner will not comment on this decision as each application is examined on its own merits according to the current guidelines of examination as set forth by the USPTO and a discussion on the facts/arguments/cited prior art of that case would require a detailed review of the record, which would be improper herein.

With regard to the specific passages cited in the declaration from Simons et al., Cowan, Gadiant, Nunes, Ravindran, Spring, Esteve-Garcia et al., it is noted that none of these references define the term "pelletting stability" as "stability of the enzyme after the pelletting process". All the passages cited refer to the effects of pelletting conditions on the enzymatic activity of phytases but they do not define the term "pelletting stability" as "stability of a phytase after pelletting", they do not use the term at all, nor do they indicate implicitly or explicitly that one should understand the term "pelletting stability" as "stability of a phytase after pelletting". With regard to the use of the term "pelletting stability" in the Wyss reference, it is noted that it is not the examiner's contention that the term "pelletting stability" cannot be interpreted as "enzyme stability after pelletting". However, as previously indicated, in its broadest reasonable interpretation, the term can certainly be interpreted as referring to the structural stability of the pellet and none of the references cited by Applicant teach that this term cannot be interpreted that way. While

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Applicant can be his/her own lexicographer, when more than one reasonable interpretation exist, as is the case herein, Applicant should provide a clear statement of how Applicant wishes the term to be interpreted. Since the specification does not provide a clear definition of the intended meaning of the term, and there is more than one meaning for the term, one cannot reasonably determine the entire scope of the claims or whether a teaching of the prior art meets the recited limitation. For examination purposes, no patentable weight will be given to the term. Correction is required.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
7. Claim 23 and 47 were rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen et al. (WO 95/28850, November 2, 1995) in view of Ghani (U.S. Patent No. 6120811, filed 10/4/1996) and Haarasilta (GB 2-139868A, 1984) as applied to claims 22 and 46, and further in view of Markussen et al. (U.S. Patent No. 4106991, 1978). In view of Applicant's cancellation of claims 23 and 47, this rejection is hereby withdrawn.
8. Claims 18-19, 21, 24, 26-28, 31-35, 41-45, 48, 50-52 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen et al. (WO 95/28850, November 2, 1995) in view of Ghani (U.S. Patent No. 6120811, filed 10/4/1996).
9. Claims 22, 46 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen et al. (WO 95/28850, November 2, 1995) in view of Ghani (U.S. Patent No. 6120811, filed 10/4/1996) as applied to claims 18-19, 21, 24, 26-28, 31-35, 41-45, 48, 50-52 above, and further in view of Markussen et al. (U.S. Patent No. 4106991, 1978).

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10. Claims 18-19, 21-22, 24, 26-28, 31-35, 41-46, 48, 50-52 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Nielsen et al. (WO 95/28850, November 2, 1995) in view of Ghani (U.S. Patent No. 6120811, filed 10/4/1996), and further in view of Haarasilta (GB 2-139868A, 1984).

11. It is reiterated herein that these rejections have been discussed at length in previous Office actions and they are maintained for the reasons of record and those set forth below.

12. Applicant traverses these rejections for the reasons of record and the arguments in favor of giving the limitation "increased pelleting stability" patentable weight. Applicant also argues that the Examiner's argument is based on inherency, namely the increased pelleting activity of any phytase granulate having at least 6000 FT/gram, and that the examiner has erroneously applied the principles of inherency in her analysis of obviousness, citing case law in support of the argument that obviousness cannot be predicated on what is not known at the time the invention was made, even if the inherency of a certain feature is later established. Since none of the references cited by the Examiner discuss pelleting stability, the Examiner cannot use inherency as a substitute for some teaching, suggestion or motivation to combine references.

13. Applicant's arguments have been fully considered but are not deemed persuasive to overcome the instant rejections. The Examiner acknowledges Applicant's citation of case law and the MPEP, as well as arguments regarding the patentable weight of the term "pelleting stability". However, the Examiner disagrees with Applicant's contention that in the instant case, inherency has been used as substitute for teaching/suggestion/motivation to combine the cited references. Applicant is reminded that the Examiner has never made the argument that one of skill in the art would have been motivated to combine the teachings of Nielsen, Ghani, Haarasilta and Markussen to obtain a granulate with "higher pelleting stability". Thus, Applicant's arguments regarding the improper use of inherency in the obviousness rejection applied are not deemed persuasive and irrelevant to the issue at hand. It is reiterated herein that the "inherency" argument made is in reference to a property/characteristic required in the claimed product, which the specification and applicant suggest as being a property of any granulate having the

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same phytase activity as that of the granulate of Nielsen et al., i.e., at least 6000 FTU/gram. For the reasons extensively discussed above, the term “increased pelleting stability” has not been given any patentable weight. However, even if the term were to be given patentable weight, it is reiterated herein that Applicant has argued throughout the prosecution of the instant application that it is the high phytase activity of the granulate, namely at least 6000 FTU/gram, which results in higher stability of the phytase in the pellet, and not the identity of the phytase used in the granulate. Thus, based on Applicant’s own arguments, any phytase granulate wherein the phytase activity is at least 6000 FTU/gram would have the recited “increased pelleting stability”. In view of the fact that the granulate of Nielsen alone has at least 6000 FTU/gram, and neither the specification nor the art teach that the carrier/hydrophobic/gel-forming/water insoluble compound has any effect on the stability of the phytase after pelleting, one of skill in the art would have to conclude that the granulate of Nielsen, Ghani, Markussen and Haarasilta would meet the desired limitation.

Conclusion

14. No claim is in condition for allowance.
15. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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16. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PMR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Delia M. Ramirez whose telephone number is (571) 272-0938. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Nashaat Nashed can be reached on (571) 272-0934. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

/Delia M. Ramirez/

Delia M. Ramirez, Ph.D.
Primary Patent Examiner
Art Unit 1652

DR
May 6, 2008